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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,866	07/15/2003	Mariana Benitez Pelaez	42430-10650	7771
47377	7590	03/27/2006	EXAMINER	
JENNER & BLOCK LLP ONE IBM PLAZA CHICAGO, IL 60611			TIEU, BENNY QUOC	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/619,866	PELAEZ ET AL.	
	Examiner	Art Unit	
	Benny Q. Tieu	2642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on Feb 7, 2006 has been entered. Claims 8, 10 and 11 have been amended. Claims 1-7 and 9 have been canceled. Claims 12 and 13 have been added. Claims 8 and 10-13 are still pending in this application, with claim 8 being independent.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 10 recites the limitation "user device profile" in lines 3 and 4. There is insufficient antecedent basis for this limitation in the claim. It is not clear user device profile belongs to calling user or called user. For examination purposes, it is assumed that the user device profile belongs to the calling user.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2642

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 8 and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by

Deshpande et al. (U.S. Patent Application Publication No. 2003/0039340).

Regarding claim 8, Deshpande et al. teach a method for receiving text messages in a telecommunications network, the method comprising the steps of:

receiving an incoming call from a calling user device (Fig. 1, 130-1) coupled to the telecommunications network (Fig. 1, 100) to a called user device (Fig. 1, 130-2) coupled to the telecommunications network (Fig. 1, 100);

sending an indication of the incoming call to the called user device including an option to receive voice or text (Fig. 3, 315);

receiving a response from the called user device indicating that text is desired (Fig. 3, 330; it is noted that when speech is not selected, it means the called party selects text);

sending to the calling user device an indication that text is desired (not shown);

determining whether the calling user device will respond with text or voice (Fig. 2, 210);

in response to an indication that the calling user device will send text, receiving a first text message from the calling user device (Fig. 2, 220); and

sending the first text message to the called user device (Fig. 3, 330).

Regarding claim 11, Deshpande et al. further teach the method wherein the step of determining whether the calling user will respond with voice or text includes receiving a

Art Unit: 2642

response from the calling user device indicating whether the calling user device will respond in voice or text (Fig. 2, 215).

Regarding claim 12, Deshpande et al. further teach the method wherein the first text message is sent over a packet-based network (page 2, [0017]).

Regarding claim 13, Deshpande et al. further teach the method wherein in response to an indication that the calling user device will send voice, receiving a voice message from the calling device and converting the voice message into the first text message (Fig. 2, 215).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2642

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Deshpande et al. in view of Mani (U.S. Patent No. 6,628,763).

Regarding claim 10, Deshpande et al. fail to teach the method wherein the step of determining whether the calling user device will respond with voice or text includes checking device profile. However, Mani teaches the method that based upon calling party's profile and/or calling party's terminal capabilities (e.g. multimedia-capable terminal), a predetermined call treatment is provided to the calling party (Fig. 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of profile feature taught by Mani to modify the method disclosed by Deshpande et al. in order to faster processing the call instead of waiting for caller's option to key in thereby the traffic in the telecommunications network will be reduced.

Response to Arguments

10. Applicant's arguments with respect to claims 8 and 10-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Casellini (U.S. Patent No. 6,404,860) teaches a system and method for internet call management with text-to-speech messaging. Chaturvede et al. (U.S. Patent No. 6,950,501) teach an Internet-based message translation for the hearing and speech impaired. Bosik et al. (U.S.

Art Unit: 2642

Patent Application Publication No. 2003/0112930) teach a call management system responsive to network presence.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

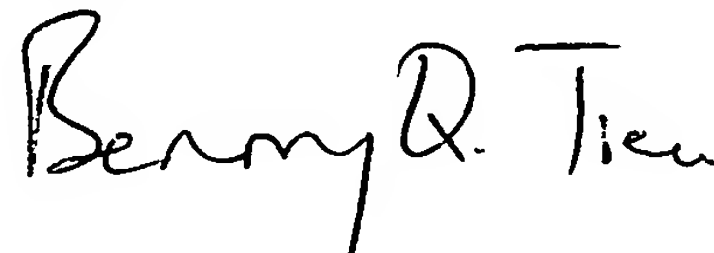
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benny Q. Tieu whose telephone number is 571-272-7490. The examiner can normally be reached on Monday-Friday: 6:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2642

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink that reads "Benny Q. Tieu". The signature is written in a cursive style with a large initial "B" and a distinct "Q".

Benny Q. Tieu
Primary Examiner
Art Unit 2642